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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) **00-0099									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 09/476,078	Filed December 30, 1999									
	First Named Inventor Charles Eric Hunter										
	Art Unit 3621	Examiner Calvin L. Hewitt II									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; text-align: center;">/ Kenneth E. Plochinski/ _____ Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="text-align: center;">Kenneth E. Plochinski _____ Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 59,166</td><td style="text-align: center;">(215) 568-3100 _____ Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="text-align: center;">December 13, 2007 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/ Kenneth E. Plochinski/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Kenneth E. Plochinski _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 59,166	(215) 568-3100 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	December 13, 2007 _____ Date
<input type="checkbox"/> applicant/inventor.	/ Kenneth E. Plochinski/ _____ Signature										
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Charles Eric Hunter

Confirmation No.: 7280

Application No.: 09/476,078

Group Art Unit: 3621

Filing Date: December 30, 1999

Examiner: Calvin L. Hewitt II

For: VIDEO AND MUSIC DISTRIBUTION SYSTEMS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS

Claims 1 – 25, 27, and 31 – 33 are pending in the application and stand rejected under 35 U.S.C. § 103(a) over Schulhof et al., U.S. Patent No. 5,572,442 (“Schulhof”) in view of Neville et al., U.S. Patent No. 6,272,636 (“Neville”). Withdrawal of the Final Rejection is believed appropriate for the following reasons.

Claim 1

In the Response to Amendments/Arguments section, the Examiner stated that “automation of a known process that accomplishes the same result as the known process is not patentable.” (Office Action dated, June 22, 2007, at p. 2-3). Applicants disagree with the characterization of the claimed process. Applicants submit that the process described in claim 1 is not a “mere automation of a known process.”

Applicants submit that Schulhof in view of Neville fails to teach or suggest at least the following recitation of claim 1:

receiving unrestricted playback selection information regarding a previously recorded music content item from a station, said station being associated with a customer, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times at the station;

The process described in claim 1 is materially different from that described by Neville. For example, Neville discloses:

If the trial evaluation is complete, the control passes to block 610 where meter code section 402 **presents a message to the user indicating the trial evaluation has terminated** and that **purchase is now required** to continue use. Code section 402 then terminates and control returns to block 600 for normal operating system control, i.e., as before the user initiated execution of product 200. (Neville, column 9, lines 46-53, emphasis added.)

If the user is not to be allowed use of this application, i.e., the **server/clearinghouse 804 determines that an evaluation period has expired**, the server does not transmit the unlock key 803 to the end-user 806 computing **device but sends and “end of evaluation” message**. (Neville, column 13, lines 31-35, emphasis added.)

If, however, the user's evaluation use has expired, then processing branches from decision block 904 to block 908 where **an expiration message may be delivered from clearinghouse 804 to the end-user 806 computing device** indicating that **execution is not allowed** and that the evaluation use has expired. (Neville, column 14, lines 9-15, emphasis added.)

The selection for unrestricted playback according to claim 1 is generated automatically, *without a need for a customer decision* or interaction, upon determining that the music content item has been played at least some predetermined number of times. Neville includes for example a clearinghouse that sends an expiration message to the end user after the evaluation period expires. This message is then displayed on a user interface of the user's terminal and the *user must then decide* and select whether they wish to purchase the full version. Applicants submit that claim 1 is not merely automating a known process, but is

rather a materially different process whereupon playing a music content item some predetermined number of times triggers the automatic generation of a selection of the item for unrestricted playback without offering the user a choice not to select the item for unrestricted playback.

Schulhof's specification describes a subscriber manually selecting program material for playback as desired (Schulhof, column 4, line 48 to column 5, line 20; column 6, lines 24-52), a subscriber manually selecting materials on a one-time basis or a subscription basis (Schulhof, column 7, line 54 to column 8, line 2), a subscriber purchasing trial subscriptions in which portions of materials are periodically deleted (Schulhof, column 9, lines 20-26), and an information request manager that manages subscriber program requests (Schulhof, column 10, lines 42-65). In no case does Schulhof describe *automatically* generating unrestricted playback selection information in response to said station determining that an item has been played *at least a predetermined number of times*.

For at least the reasons explained above, Applicants respectfully submit that the cited references, either alone or in combination, do not teach the quoted claim recitation and, therefore, claim 1 is patentably defined over the cited art.

Claims 10, 27, 31 and 32

Claim 10 recites in part:

a mechanism configured to communicate unrestricted playback selection information regarding a previously recorded music content item, which was previously recorded in the storage medium, said unrestricted playback selection information having been generated automatically upon determining that the previously recorded music content item has been played at least a predetermined number of times.

Claim 27 recites in part:

a communications module configured to communicate unrestricted playback selection information from the station, said unrestricted playback selection information having been generated automatically upon determining that a previously recorded music content item has been played at least a predetermined number of times at the station.

Claim 31 recites in part:

a second interface configured to communicate unrestricted playback selection information from the station and for receiving enabling information for enabling unrestricted playback of a previously recorded music content item, said unrestricted playback information being automatically generated and communicated upon determining the previously recorded music selection has been played at least a predetermined number of times at the station.

Claim 32 recites in part:

receiving a request for unrestricted playback rights for the music content item, said request having been generated automatically upon determining that the music content item has been played at least a predetermined number of times at the station;

The remarks presented above with respect to the quoted recitation from claim 1 apply as well to the quoted recitations from claims 10, 27, 31 and 32. Thus, for at least this reasons presented above with respect to claim 1, Applicants respectfully submit that claims 10, 27, 31, and 32 are patentably defined over the cited art.

Moreover, claim 1 recites “unrestricted playback selection information having been generated automatically upon determining that the *previously recorded music content item* has been played at least a predetermined number of times at the station.” (Claim 1, emphasis added.) Schulhof states: “when a subscriber has *completed placing the order*, a payment icon is displayed that requires the subscriber to authorize billing to his account” (Schulhof, col. 7, ll. 61-63, emphasis added) and “[o]nce the order process is completed, high speed data transfer may begin, or data transfer may be delayed until a time when the cable television line is not being used to supply television programming” (Schulhof, col. 8, ll. 5-8). That is, Schulhof teaches that an order process is completed before the content is transmitted to the user’s location. The remarks presented here with respect to the quoted recitation from claim 1 apply as well to claims 10, 27 and 31. Thus for at least these additional reasons Applicants respectfully submit that claims 1, 10, 27, and 31 are patentably defined over the cited art.

Claims 2-9, 11-25, and 33

Claims 2–9 and 24 each depends, directly or indirectly, from claim 1. Claims 11–23 and 25 each depends, directly or indirectly, from claim 10. Claim 33 depends from claim 32.

DOCKET NO.: **OO-0099
Application No.: 09/476,078
Office Action Dated: June 22, 2007

PATENT

Applicants respectfully submit that for at least the reasons explained above with respect to independent claims 1, 10, and 32, dependent claims 2-9, 11-25, and 33 are patentably defined over the cited art.

Date: December 13, 2007

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